

REMARKS

Summary

Claims 1-4, 6-11 and 13 were pending and all of the claims were rejected in the Office Action. The Applicant has carefully considered the references cited and the reasons set forth by the Examiner in the subject Office Action, and respectfully traverses the rejections on the basis that a *prima facie* case of obviousness has not been set forth. The Applicant respectfully requests reconsideration of the rejections and the withdrawal of the finality of the Office Action. The Applicant's response to the Examiner's Response in the Office Action has been incorporated in the remarks below.

Rejections

35 U.S.C. § 103 (a)

Claims 1-4 and 7-11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Sasaki (US 6,271,488; "Sasaki) in view of Painter et al. (US 5,669,485; "Painter"), and Admitted Prior Art (APA) [instant Fig. 20]. Before proceeding, the Applicant makes note that there is a lack of continuity between the bottom of page 2 and the top of page 3 in the Office Action. In order to expedite the prosecution of the application, the Applicant has attempted to respond to the Office Action as if the paragraph had repeated the rejection as stated in the earlier Office Action.

Claim 1 recites, *inter alia*, the first and second operating members being disposed so as to be positioned close to each other in one and the same plane and so that the respective axial directions are orthogonal to each other.

Claim 7 has a similar recitation.

With respect to the rejection of Claims 1 and 7, the Examiner accepts that Sasaki does not disclose a second operating member (Office Action, page 2, lines 3-4 from bottom of page) and relies on Painter to remedy this defect in the *prima facie* case.

Merely combining the switch mechanism taught by Sasaki with a suggestion found by the Examiner in Painter to use more than one switch, does not teach all of the elements and limitations of the arrangement of Claim 1; for example, the axial directions of the two switches being orthogonal to each other. Further, nothing in either reference would suggest the limitation in Claim 1 that the first and second operating members are close to each other and in the same plane.

With respect to Claims 1-3, 7, 9 and 10, the Examiner accepts that Sasaki does not teach the operating members arranged orthogonal or T-shape or L-shape. The Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the operating members arranged orthogonal or T-shape, or L-shape, in order to achieve better operability, since it has been held that rearranging parts of an invention involves only routine skill in the art. [*In re Japikse*, 88 USPQ 70]" (Office Action, page 3, lines 3-7).

In *Japikse*, the court stated: "As to that limitation it was held that there would be no invention in shifting the starting switch disclosed by Cannon to a different position since the operation of the device would not thereby be modified." (*In re Japikse*, 88 USPQ 70, CCPA 1950). [emphasis added] To the contrary, a long line of cases hold that "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears Roebuck & Co.* 722 F.2d 1542 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Since *In re Japikse* refers to the use of a reference to show anticipation, both *Japikse* and *Maschinenfabrik GmbH* deal with the same issue.

The MPEP, at §2144.04 VI.C, in discussing *In re Japikse*, states that "the prior art must provide a motivation or reason for the worker in the art, without benefit of the applicant's specification, to make the necessary changes in the

reference device.” *Ex parte* Chicago Rawhide Mfg. Co. 223 USPQ 351, 353 (BPAI 1984). The Examiner did not fulfill this requirement when citing Painter, and therefore the citation of Painter does not remedy the deficiency found in Sasaki.

Painter does not lend itself to a combination with Sasaki to teach all of the elements and limitations of the present Claim 1, as the modifications needed to Painter would render the device inoperative. Painter is directed towards “a rotary knob switch apparatus assembly [100], ... which includes a circular knob [101] ... and a first set of characters [105] and a second set of characters [107] are positioned ... around the outer edge ... of the upper surface of the knob... a viewing window is positioned 109 is positioned over the top of the knob.” (Painter, col.1, line 50 bridging col.2, line 25).

More than one knob as taught by Painter may be viewed by an observer, providing that the axes of each knob are parallel to each other (and also perpendicular to the viewing surface), permitting the characters on each knob to be viewed through a viewing window. However, if the axis of a second switch is oriented orthogonal to that of a first switch (and parallel to the viewing surface), then the characters on the second switch could not be viewed through a viewing window. This would render a two switch assembly with this configuration inoperative. There is no suggestion in Painter to put the characters on an upper surface of one knob and on an outer surface of another knob. Thus only one of the knobs would operate as taught by Painter

Alternatively, *arguendo*, one might orient two knobs so that the switch axes were both orthogonal to each other and also parallel to the display surface. In order to view the characters through the window, the characters would have to be placed on the radial edge of the knob rather than the top, but both knobs would then be wholly below the window and neither knob could be operated.

Further, “[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor.” *Para-Ordnance Mfg. v. SGS*

Importers Int'l, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), cert. denied, 519 U.S. 822 (1996)(citing W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, Appeal No. 1998-2142 Page 8 Application No. 08/125,189 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991)). The Applicant respectfully submits that the Examiner has not shown that there is a motivation to combine the references, even if they could be combined, and therefore failed to make out a *prima facie* case of obviousness.

For at least the reasons set forth above, the Examiner has not made out a *prima facie* case of obviousness, and Claim 1 is allowable. Claims 2-4 and 6, being claims dependent on an allowable claim are allowable, without more. Claim 7 recites subject matter in common with Claim 1 and is allowable for at least the same reasons. Claims 8-11 and 13, being claims dependent on an allowable claim are allowable, without more.

The Examiner has made further rejections of Claims 1, 6 and 13, based on the above references and the Admitted Prior Art (APA). As the Applicant has already shown that a *prima facie* case of obviousness has not been made out, and the APA is not cited to remedy the previously noted defects in the *prima facie* case, it is not necessary to specifically traverse these rejections.

In the Office Action Response to Arguments, the Examiner points out that the intent of citing the APA was to show that Sasaki suggested a multifunction operating member to perform multiple functions, and not to suggest the use of multiple switches. Since Sasaki emphasized multifunction, the implication is that the functions should be performed with a single switch operable in three directions rather than separate switches. The Applicant respectfully submits that this shows a clear preference for a design

with one switch rather than multiple switches. By such a teaching, not only does Sasaki not teach a second operating switch, as the Examiner agrees, Sasaki actually teaches away from a second switch as the Applicant has previously argued.

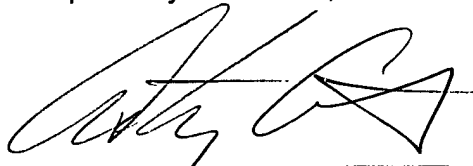
Conclusion

Claims 1-4, 6-11 and 13 are pending.

For at least the reasons given above, the Applicant respectfully submits that the pending claims are allowable and request that a Notice of Allowance issue.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', written over a horizontal line.

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